

REMARKS

Claims 1-31 are pending in the patent application. Claims 1-31 were rejected in the office action mailed on June 21, 2005.

Information Disclosure Statement

The Applicant respectfully notes that all of the Foreign Patent Documents and Other Art Cited listed in the Information Disclosure Statement ("IDS") submitted on April 22, 2004 and the IDS submitted on October 19, 2004 are located within the Cummins-Allison library at PK5-5T11 as mentioned in the Information Disclosure Statements. The Cummins-Allison library was created in cooperation with the Patent and Trademark Office ("PTO") in an effort to reduce the number of copies of references that were sent to the PTO, to attempt to assist the Examiners. As a result of the Cummins-Allison library, copies of documents located within the library are not submitted with an IDS, but the reference number indicating the location of the reference within the Cummins-Allison library is provided. For example, Foreign Patent Document DE 2659929 may be found as reference C1 within the Cummins-Allison library. As Applicants' Attorney discussed with Examiner Matthews in a telephonic conference on September 19, 2005, the foreign references and other art cited within IDSs submitted in this case are located within the Cummins-Allison library. As a result, Applicants respectfully believe that the IDS submitted on April 22, 2004 and the IDS submitted on October 19, 2004 are compliant, and Applicants respectfully request that the Examiner consider the references contained therein. Copies of the foreign references and other art cited within the IDSs and located within the Cummins-Allison library is enclosed for the Examiner's convenience.

35 U.S.C. § 103 Rejection

Claims 1-31 were rejected based on 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,278,795 ("Anderson") in view of U.S. Patent No. 5,423,527 ("Tranquilla"). One basic requirement for a *prima facie* case of obviousness is that there must be some suggestion or motivation to combine the reference teachings. M.P.E.P. § 2143. Anderson in view of Tranquilla does not satisfy this test. Another requirement for a *prima facie* case of obviousness is that the prior

art references must teach or suggest all of the claim limitations. M.P.E.P. § 2143. Anderson in view of Tranquilla does not satisfy this test.

The Examiner has stated that:

Anderson does not disclose a transportation mechanism including a first portion adapted to transport bills at a first speed and a second portion adapted to transport bills at a second speed or a controller adapted to cause the first portion and the second portion of the transport mechanism to transport bills at substantially the same speed when the distance between consecutive bills transported by the transport mechanism is at least a predetermined distance, the controller being adapted to cause the first portion of the transport mechanism to slow the speed at which bills are transported such that the first speed is less than the second speed when the evaluation unit determines the distance between two consecutive bills transported by the transport mechanism is less than the predetermined distance.

Thus, Tranquilla must supply the teaching lacking in Anderson. However, the disclosure of Tranquilla teaches away from the claimed invention. Tranquilla is generally directed to a document transport mechanism and a method of adjusting the spacing between consecutive documents within the document transport mechanism.

Tranquilla states that an object of his invention is “provide means for spacing correction, performed by changing the transport speed in an intermediate section of the transport, rather than by changing transport speed at the input segment of the transport.” Col. 2, ll. 29-33. Tranquilla additionally teaches “spacing correction is performed by automatically changing transport speed at a ‘intermediate’ transport segment, rather than by changing transport speed for an initial (input) segment.” Col. 7, ll. 10-13. Tranquilla continues, “[w]orkers will recognize that since rollers, etc. in the initial transport segment often necessarily have large inertias ... these inertias make it impractical, or difficult, to decelerate documents therewith by way of correcting (increasing) document spacing.” Col. 7, ll. 14-20. “Accordingly, this is better done with an ‘intermediate’ transport segment, as here described.” Col. 7, ll. 20-22. Therefore, one skilled in the art would learn from Tranquilla that the speed of operation of the initial transport segment of a transport mechanism should not be modified in order to correct the spacing of consecutive documents in the transport mechanism.

Independent claims 1 and 13 have been amended to each recite a “transport mechanism including a first portion, including a first drive roll of the transport mechanism, adapted to transport bills at a first speed and a second portion adapted to transport bills at a second speed,” making clear that the first portion of the transport mechanism includes the first drive roll of the transport mechanism adapted to remove currency bills from the input receptacle. Therefore, independent claims 1 and 13 recite slowing the first portion of the transport mechanism, which also slows the speed at which currency bills are moved in the input section, to a speed less than the speed of the second portion of the transport mechanism “when the distance between two consecutive bills is less than a predetermined distance.” Thus, the amended independent claims 1 and 13 recite a concept that is taught away from by Tranquilla. Therefore, one skilled in the art would not combine Anderson and Tranquilla to arrive at the present invention of claims 1 and 13.

Independent claim 18 has been amended to recite a “transportation mechanism including a first portion, including a first drive roll of the transport mechanism downstream of the input receptacle, adapted to transport bills at a first speed and a second portion adapted to transport bills at a second speed,” making clear that the first portion of the transport mechanism of claim 18 includes the very first drive roll of the transport mechanism downstream of the input receptacle. Therefore, independent claim 18 recites slowing the first portion of the transport mechanism, which also slows the speed at which currency bills are moved in the input section of the transport mechanism, to a speed less than the speed of the second portion of the transport mechanism “when the distance between two consecutive bills is less than a predetermined distance.” Thus, the amended independent claim 18 recites a concept that is taught away from by Tranquilla. Therefore, one skilled in the art would not combine Anderson and Tranquilla to arrive at the present invention of claim 18.

As one skilled in the art would not combine Anderson and Tranquilla, and neither Anderson nor Tranquilla individually disclose all of the limitations of the pending independent claims, a *prima facie* case of obviousness has not been made.

Claims 2-12 depend either directly or indirectly from claim 1. As not all of the limitations of claim 1 are taught or suggested by Anderson in view of Tranquilla, not all of the

limitations of claims 2-12 are taught or suggested by Anderson in view of Tranquilla, as one skilled in the art would not look to combine the teachings of Anderson and Tranquilla.

Claims 14-17 depend either directly or indirectly from claim 13. As not all of the limitations of claim 13 are taught or suggested by Anderson in view of Tranquilla, not all of the limitations of claims 14-17 are taught or suggested by Anderson in view of Tranquilla, as one skilled in the art would not look to combine the teachings of Anderson and Tranquilla..

Claims 19-31 depend either directly or indirectly from claim 18. As not all of the limitations of claim 18 are taught or suggested by Anderson in view of Tranquilla, not all of the limitations of claims 19-31 are taught or suggested by Anderson in view of Tranquilla, as one skilled in the art would not look to combine the teachings of Anderson and Tranquilla..

Conclusion

The Applicants submit that the claims are in a condition for allowance and action toward that end is earnestly solicited. No additional fees are believed due with this paper. Should any additional fees be required (except for payment of the issue fee), the Commissioner is authorized to deduct the fees from Jenkins & Gilchrist, P.C. Deposit Account No. 10-0447, Order No. 47171-00409USPT.

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Respectfully submitted,

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